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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,904	02/28/2002	Jon Gelsey	042390.P13786	4050
7590 05/18/2005 Blakely, Sokoloff, Taylor & Zafman Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1030			EXAMINER ALEJANDRO, RAYMOND	
			ART UNIT 1745	PAPER NUMBER

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ml

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p>Application No. 10/086,904</p>	<p>Applicant(s) GELSEY, JON</p>	
	<p>Examiner Raymond Alejandro</p>	<p>Art Unit 1745</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 28 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 65,66,72-77 and 79-82.
- Claim(s) withdrawn from consideration: 67-71, 78 and 83-97.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

  
 Raymond Alejandro  
 Primary Examiner  
 Art Unit: 1745  
**RAYMOND ALEJANDRO**  
**PRIMARY EXAMINER**

***Response to Arguments***

1. Applicant's arguments filed 04/28/05 have been fully considered but they are not persuasive.

2. With respect to applicant's arguments regarding the Election/Restriction, it is still contended that claims 67-71, 78 and 83-97 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: during this prosecution applicants initially elected to have examined the claims of Group I and particularly Species 2 (now cancelled claims 2-3, 10-14 and 24-29; and cancelled claims 30, 34-35, 37-43, 56-58 and 60-64) in response to the restriction requirement of 10/24/03 and 11/10/03. Accordingly, the examiner has currently identified and grouped claims 65-66, 72-77 and 79-82 as being directed to substantially the same subject matter of all cancelled claims. Thus, the remaining claims (claims 67-71, 78 and 83-97) are now deemed to be directed to mutually exclusive species claiming separate and/or distinct inventions, embodiments and/or characteristics. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 67-71, 78 and 83-97 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

(***emphasis added***→) Additionally, it is further noted that the subject matter of independent claim 83 appears to encompass either a different embodiment and/or a separate and unrelated invention at least because of different mode of operations or different functions (See also MPEP 806.04 and 808.01). For instance, the subject matter of independent claim 65 strictly requires the employment of both an endothermic hydrogen generator and an exothermic

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hydrogen generator so as to generate hydrogen by apparently the heat transfer therebetween; on the other hand, the subject matter of independent claim 83 does not require that the hydrogen generators be either endothermic or exothermic, in fact, it encompasses the use of any known hydrogen generator regardless of its functionality. Accordingly, the examiner reiterates that the inventions of independent claims 65 and 83, respectively, represent separate and unrelated inventions at least because they have different modes of operation or different functions.

Furthermore, applicant has not pointed out where the subject matter of claim 83 and its dependent claims are supported, nor does there appear to be a written description of the claim limitations “*endothermic and exothermic compartments*” and the use of “*any known hydrogen generator regardless of its functionality*” in the application as filed. That is to say, such claimed subject matter does not appear to be adequately described in the original disclosure. Yet more, after a thorough review of the specification as filed, it has been noted that it does not reasonably provide enablement for the combined use of respective endothermic and exothermic compartments and any hydrogen generators, that is, how the endothermic and exothermic characteristic of the compartments can be used to positively affect any known hydrogen generator; what if: *a regular-standard hydrogen generator is included in the endothermic compartment, or an exothermic hydrogen generator is included in the endothermic compartment, or an endothermic hydrogen generator is included in the endothermic compartment in combination with a regular-standard hydrogen generator being included in the exothermic compartment, or an exothermic hydrogen generator being included in the exothermic compartment, or an endothermic hydrogen generator being included in the exothermic compartment.* Accordingly, the specification as filed does not enable the skilled artisan to

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produce hydrogen under some of the aforementioned possible combinations (e.g. an exothermic hydrogen generator included in the endothermic compartment in combination with an exothermic hydrogen generator being included in the exothermic compartment) Thus, the subject matter of claim 83 and its dependent claim would raise the issue of new matter.


3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "using an exothermic hydrogen generator in one compartment to transfer heat to an endothermic hydrogen generator in another compartment") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It appears that applicants are attempting to conveniently accommodate the presently claimed language (i.e. first compartment and second compartment) to read as necessarily requiring the presence of two separate, divided, detached, unconnected or individual compartments. Indeed, the examiner has construed the presently claimed language as having an apparatus comprising two parts or two sections (i.e. not necessarily containers, enclosures or compartment physically separated from each other) configured to carrying out the exothermic and endothermic hydrogen generation in the same container. Additionally, it is noted that applicant admitted the following: "Long teaches that the primary and second chemical hydrides be included in the same container" (See amendment of 04/28/05 at page 10, 4<sup>th</sup> paragraph). Thus, it is verily believed that the prior art of record still meets both the functional and structural interrelationship to satisfy the claimed requirement.

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4. In response to applicant's argument that "*Long discusses specific positioning of the chemical composition (i.e. "outlet of water conduit", "first chemical hydride")*", the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). *In this particular case, the examiner points out that the Long reference has been cited in the office action to show the general concept of having a chemical apparatus configured to and adapted to exothermically and endothermically generate hydrogen per se.*

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In this case, both references (i.e. Long and Basch) are pertinent to one another as they both address the same problem of reliably providing generation of hydrogen for chemical applications and regardless the ultimate intended use thereof.*

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). *This is to address applicant's intention of independently discussing the teachings of Long and Basch.*

  
RAYMOND ALEJANDRO  
PRIMARY EXAMINER